

REMARKS

A telephone interview was conducted Tuesday, December 5, 2006 between Examiner Richard Lee and applicants' representative George Blasiak. At the beginning of the interview applicants' representative made a preliminary statement substantially as follows:

The interview will be focused on a limited number of issues for purposes of reducing the time of the interview, and for purposes of expediting an allowance. The focused nature of the interview will not be taken as an indication that arguments for unpatentability by the Examiner not discussed are conceded to be correct and appropriately made by applicants. Applicants' expressly reserve the right, later in prosecution of the present application or another application, to challenge the propriety of the outstanding office action on grounds not discussed in the interview.

Applicants' representative also stated the requirements for an obviousness based rejection as follows:

According to *MPEP* §2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. (emphasis added) *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The telephone interview focused on the teachings of Maruoka. The relied upon section of Maruoka is as follows:

In the B-MAC system shown in Fig. 1A, the digital audio signal and independent data are subject to binary or binary quaternary conversion, time-divided in the baseband during the retrace interval of the video signal, and frequency modulated together with the video signal. *Maruoka U. S. Patent No. 5,257,106, column 1, lines 59-64*

In the office action of August 8, 2006 the Examiner maintained the position that "independent data" *discloses* control data: "Maruoka however discloses...multiplexing of audio signal and independent data (i.e., control data)."

During the telephone interview applicants' representative requested the Examiner to explain why the Examiner believes that independent data of Maruoka is control data. The Examiner responded that a receiving circuit for the Maruoka signal must have control data to be operational. In response to this explanation by the

Examiner, applicants' representative responded that if taken as true, the Examiner's explanation would still not evidence that the claim limitations requiring a control signal time division multiplexed in retrace periods are suggested or disclosed. Applicants' representative pointed out that U. S. Patent No. 6,560,282 to Tahara et al. ("Tahara") relied upon by the Examiner has teachings (e.g., column 24) relating to encoding a control signal in a base band signal (i.e., not in retrace period), contrary to applicants' claims.

Eventually the Examiner modified the Examiner's original position regarding Maruoka that Maruoka *discloses* a control signal as recited in applicants' claims. The Examiner conceded that Maruoka's teaching of independent data is merely "suggestive" of a control signal.

Applicants' representative further requested the Examiner to explain, even if the "independent data" were taken as a teaching of a control signal, where in Maruoka there is a teaching in Maruoka disclosing or suggesting a control signal, being generated based on a compressively coded signal in satisfaction of specific recitations of applicants' claims. In response, the Examiner did not point to a specific reference of Maruoka. The Examiner made reference to Fig. 1B of Maruoka and stated that Fig. 1B is suggestive of generating a control signal based on a compressively coded signal.

During the interview the Examiner stated that "independent data" "could be anything." The Examiner agreed with applicants' representative that "independent data" of Maruoka could be interpreted to be a reference to data other than a control signal. The Examiner agreed that independent data of Maruoka could be mere presentation data not used for control of any circuit (e.g., a time stamp).

Accordingly, in view of the above remarks, applicants believe all of the claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

Communication to Record Substance of Interview dated December 8, 2006

If the Examiner believes that contact with applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicants' representative at the phone number listed below.

The Commissioner is hereby authorized to charge any fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Dated: December 8, 2006

Respectfully submitted,

By George S. Blasiak

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